



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Ne

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/310,800 05/12/99 CHAUG

Y 96-017-TAX

EXAMINER

LM02/0323

WAYNE P BAILEY
STORAGE TECHNOLOGY CORPORATION
ONE STORAGE TEK DRIVE
MS 4309
LOUISVILLE CO 80028-4309

TUPPER, R

ART UNIT

PAPER NUMBER

2754

DATE MAILED:

03/23/00

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/310,800

Applicant(s)
Chuang

Examiner
R. S. Tupper

Group Art Unit
2754



☒ Responsive to communication(s) filed on Jan 10, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 3-6, 8-14, and 16-28 is/are pending in the application.

Of the above, claim(s) 11-14 and 16-18 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-6, 8-10, and 19-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2754

1. Claims 11-14 and 16-18 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 5.

2. Claims 1, 3-6, 8-10, and 19-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, and 19 fail to clearly indicate how many individual heads are involved, and where the gluing vias are located relative to the head(s).

The following are indefinite: "tracks" (claim 21) and "track" (claim 27) are indefinite.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude"

Art Unit: 2754

granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3-6, 8-10, and 19-28 are rejected under the judicially created doctrine of double patenting over claims 1-10 of U. S. Patent No.

Art Unit: 2754

5,943,196 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a head structure having a thin film on a substrate, a C-core, and a plurality of gluing vias.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on

Art Unit: 2754

sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-6, 8-10, and 19-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by TSUTAKI et al (5,022,140).

Note figures 3A-3F. Concerning the method limitations in claims 5, 10, and 19, these have been accorded weight to the extent they affect the completed structures being claimed.

7. Applicant's arguments filed Jan 10, 2000 have been fully considered but they are not persuasive.

Applicant argues that the claims recite a "magnetic head", and cannot understand how they are indefinite.

Magnetic heads have structural features such as pole pieces, gap(s), coils, etc, that when operated record to form a recorded track(s) on a magnetic medium or reproduce from a previously recorded track on the medium.

Applicant has misused the terms "tracks" and "track" in many of the claims to define structural features of the head. Track(s) exist on the medium.

Art Unit: 2754

Furthermore, in claims 1 and 6, the recitations refer to a plurality of layers. This is also indefinite since a plurality of layers can be used to form one set pole pieces to record one track on a medium; or a plurality of sets of pole pieces to record a plurality of tracks on a medium. Thus it is unclear how many heads are involved.

Applicant also asserts that this application is a divisional, and again cannot understand how they are subject to a double patenting rejection.

The subject matter of these claims was not restricted out of the parent application by the Examiner. Applicant has presented this application voluntarily, and thus these claims are properly subject to a double patenting rejection.

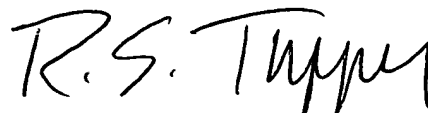
Concerning the rejection over TSUTAKI et al, Applicant argues that TSUTAKI et al does not show a thin film layer. This is in error.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2754

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Tupper whose telephone number is (703) 308-1601.



ROBERT S. TUPPER
PRIMARY EXAMINER
GROUP 2500